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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,552	01/26/1999	WATARU TOMIDA	102654	1322

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/236,552

Applicant(s)

TOMIDA, WATARU

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 18, 19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 18, 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/14/03, and has been entered and made of record. Currently, **claims 14-16, 18, 19, 21, and 22** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 14 and 21** have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. The objection to **claim 18**, as cited in the Office action dated 12/17/02, is overcome by the changes set forth in the amendment.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 14, 16, 18, 19, 21, and 22** are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper *et al.* (U.S. Patent Number 6,052,442).

Regarding **claim 14**, Cooper discloses an internet facsimile device (see Fig. 1, column 6, lines 30 through 65) of a receiving party comprising means for receiving by the internet facsimile device via an internet at least one set of electronic mail data (column 6, lines 30 through 14) attached with an electronic mail title (see Fig. 4, being included in the header of the message, column 9, lines 7 through 39), means for reading the electronic mail title (column 6, lines 30 through 42), means for displaying the electronic mail title that has been received along with the electronic mail data (column 7, lines 1 through 53), means for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 7, lines 15 through 34), means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (column 6, lines 16 through 42), and means for forming an image based on electronic mail data selected by the data selecting means (column 7, lines 20 through 53), wherein the internet facsimile device displays the received electronic mail title (see Fig. 4, column 9, lines 7 through 49), and wherein the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 6, line 30 through column 7, line 53), whereby the

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internet facsimile device prints the image formed by the image forming means (via printer 36, seen in Fig. 1, column 7, lines 28 through 41).

Regarding **claim 16**, Cooper discloses the device discussed above in claim 14, and further teaches of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (column 6, lines 16 through 65, particularly lines 40 through 42), and means for notifying the user of electronic mail data having the high priority (column 6, lines 16 through 65, wherein the system initiates a page to the user).

Regarding **claim 18**, Cooper discloses the device discussed above in claim 14, and further teaches of means for notifying a user when the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 6, lines 16 through 65).

Regarding **claim 19**, Cooper discloses the device discussed above in claim 14, and further teaches that the priority determining means determines that a priority is high when corresponding electronic mail title contains a predetermined character (column 6, lines 40 through 42).

Regarding **claim 21**, Cooper discloses a method of controlling an internet facsimile device (see Fig. 1, column 6, lines 30 through 65) of a receiving party comprising the steps of receiving electronic mail (column 6, lines 30 through 14) attached with a header by the internet facsimile device from internet facsimile device, the header including a title (see Fig. 4, being included in the header of the message, column 9, lines 7 through 39), reading the title from the header (column 6, lines 30 through 42), displaying the title that has been received along with the electronic mail data (column 7, lines 1 through 53), determining whether or not the electronic

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mail has a high priority based on a corresponding electronic mail title (column 6, lines 16 through 42), and forming an image based on the electronic mail which has been determined to have a high priority (column 6, line 30 through column 7, line 53), wherein the internet facsimile device displays the received electronic mail title (see Fig. 4, column 9, lines 7 through 49) and prints the image formed based on the electronic mail which has been determined to have a high priority (via printer 36, seen in Fig. 1, column 6, line 30 through column 7, line 41).

Regarding *claim 22*, Cooper discloses the method discussed above in claim 21, and further teaches of determining whether or not the electronic mail belongs to a predetermined group based on the title (column 6, lines 16 through 65, particularly lines 40 through 42), and notifying a user of an urgent mail when the electronic mail belongs to the predetermined group (column 6, lines 16 through 65, wherein the system initiates a page to the user).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442) in view of Owens *et al.* (U.S. Patent Number 6,023,700, cited in the Office action dated 12/17/02).

Regarding *claim 15*, Cooper discloses the device discussed above in claim 14, and further teaches of including a second receiving means for receiving data via a public network (column 5,

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lines 40 through 63), but fails to particularly teach of receiving facsimile data via the public network and a data converting means for converting the at least one set of the electronic mail data into facsimile data, with the image forming means forms an image based on the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data. Owens discloses an internet facsimile device (electronic mail service 10, column 4, lines 5 through 40) comprising means for receiving by the internet facsimile device via an internet at least one set of electronic mail data (column 4, lines 21 through 65, and column 5, lines 37 through 66) attached with an electronic mail title (see Fig. 3, column 6, lines 19 through 44), means for reading the electronic mail title (column 47 through column 6, line 44), means for displaying the electronic mail title that has been received along with the electronic mail data (column 3, lines 38 through 48), means for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 5, line 47 through column 6, line 44), and means for forming an image based on electronic mail data selected by the data selecting means (column 5, lines 19 through 36), wherein the internet facsimile device displays the received electronic mail title (see Fig. 3, column 6, lines 19 through 57, and column 7, lines 1 through 40). Owens further teaches of including a second receiving means for receiving facsimile data via a public network (column 5, lines 34 through 36, and column 7, lines 1 through 40), and data converting means for converting the at least one set of the electronic mail data into facsimile data (see abstract, column 4, line 53 through column 5, line 36, and column 7, lines 1 through 17), wherein the image forming means forms an image based on the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data (column 5, lines 34 through 36, and column 7, lies 1 through 40).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Owens in the system of Cooper. Cooper's system would easily be modified to include the teachings of Owens, as the systems share cumulative features, being additive in nature.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
May 29, 2003



EDWARD COLES
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